

## **REMARKS/ARGUMENTS**

Reconsideration and withdrawal of the rejection of the application are respectfully requested in view of the following remarks.

### **I. STATUS OF THE CLAIMS AND FORMAL MATTERS**

Claims 1-16 are currently pending.

### **II. REJECTIONS UNDER 35 U.S.C. §103(a)**

Claims 1-16 were rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,154,600 to Newman et al. (hereinafter, merely "Newman") in view of U. S. Patent No. 6,535,252 to Bruls (hereinafter, merely "Bruls").

Claim 1 recites, *inter alia*:

"A video editing device for use with a computer readable recording and playing device operable to allow video material recording and playback and to allow non-linear editing of the video material, comprising ...

an output module that receives, from an image conversion object, a buffer address indicating where the retrieved video frame is stored and a corresponding time code ..." (emphasis added)

As understood by Applicants, Newman relates to a media editor for the storage, editing and retrieval of audio/visual information. Users may replay the captured hypermedia in addition to selectively capturing and manipulating hypermedia portions, or clips, using a graphical user interface (GUI). Captured clips appear as icons on the GUI and users may combine clips to affect a wide variety of editing functions. On the other hand, Bruls relates to a device for receiving, storing and displaying television images. The device comprises a buffer for storing television images. A number of consecutive television images stored in the buffer lie

between a television image read at a given instant from the buffer and a television image stored at substantially the same instant. This device makes it possible to start to watch television images simultaneously at the instant of their reception, while television images received at a later instant and not yet displayed, for example, a block of commercials, can be watched in an accelerated manner.

In paragraph 4 of the Office Action, the Examiner contends that in light of the teaching in Bruls, it would have been obvious to one of ordinary skill in the art to modify Newman by providing a buffer address and a corresponding time code in order to read the selected image from the buffer. Applicants respectfully disagree.

Firstly, there is no suggestion or teaching in Newman for the use of an output module that can receives from an image conversion object, a buffer address indicating where the retrieved video frame is stored and a time code corresponding to the video frame. Applicants respectfully submit that Newman merely discloses the use of an output device such as a television (Newman, col. 6, lines 12-24). There is no motivation for a person skilled in the art, after reading the disclosure of Newman, for using an output module that can buffer images from an image conversion object and indicate where the retrieved video frame is stored while buffering, along with an indication of a time code corresponding to the stored video frame. Additionally, Bruls does not teach or suggest the use of its buffer device with a non-linear media editor as disclosed in the instant invention and Newman. Bruls merely discloses the use of a buffer device with storage means to store television images that can be watched in an accelerated manner at a later stage. Therefore Applicants submit that there is no motivation for a person skilled in the art to combine Newman and Bruls, based on their individual teachings.

Applicants respectfully submit that the Office Action has relied on impermissible hindsight. To establish a *prima facie* case of obviousness, three basic criteria must be met. First, even if the cited references are from the same/related field, there must be some suggestion or motivation to modify the reference or to combine reference teachings either in the references themselves or in the general knowledge available to one of ordinary skill in the art; second, there must be a reasonable expectation of success; third, the prior art reference or references must teach or suggest all the claim limitations. M.P.E.P. § 2143. It is, however, impermissible for the Examiner to use hindsight based on an Applicant's disclosure to determine that an Applicants' invention is obvious in view of the cited art. M.P.E.P. § 2142. The motivation or teaching to make the claimed combination by modifying or combining prior art references must be found in the prior art and not in the Applicant's disclosure. *In re Vaeck*, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). There is nothing that would motivate a skilled worker in the art to modify Newman in view of Bruls.

Further, in *Winner Int'l Royalty Corp. v. Wang*, 202 F.3d 1340 (January 27, 2000), *reh 'g en banc denied* (March 6, 2000), *cert. denied*, 120 S. Ct. 2679 (U.S. 2000), it was held that:

“Although a reference need not expressly teach that the disclosure contained therein should be combined with another, the showing of combinability, in whatever form, must nevertheless be ‘clear and particular.’” (emphasis added).

Additionally, Applicants submit that the Examiner may not use the claimed invention as an "instruction manual" or "template" to piece together the teachings of the prior art so that the invention is rendered obvious. *In re Fritch*, 972 F.2d 1260, 23 U.S.P.Q.2d 1780 (Fed. Cir. 1992). Such reliance is an impermissible use of hindsight with the benefit of Applicants' disclosure. *Id.* Furthermore, even if the Examiner has located all the limitations of the claimed

present invention, still a fundamental notion of patent law is the concept that invention lies in the new combination of old elements. Therefore, a rule that every invention could be rejected as obvious by merely locating each element of the invention in the prior art and combining the references to formulate an obviousness rejection is inconsistent with the very nature of "invention." Consequently, a rule exists that a combination of references made to establish a *prima facie* case of obviousness must be supported by some teaching, suggestion, or incentive contained in the prior art which would have led one of ordinary skill in the art to make the claimed invention. The inquiry is not whether each element existed in the prior art, but whether the invention as a whole is obvious in light of the prior art. *Hartness International, Inc. v. Simplicatic Engineering Co.*, 819 F.2d 100, 2 U.S.P.Q.2d 1826 (Fed. Cir. 1987). Applicants respectfully point out that the Examiner has established a pattern of allegedly locating each element of the invention in the prior art and then combining the references to formulate the obviousness rejections.

For at least this reason of reconstruction based on impermissible hindsight, claim 1 should be allowed.

Claims 8, 15, and 16 are similar, or somewhat similar, in scope to claim 1, and are therefore patentable for similar, or somewhat similar, reasons.

### **III. DEPENDENT CLAIMS**

The other claims are dependent from one of the independent claims, discussed above, and are therefore believed patentable for at least the same reasons. Since each dependent claim is also deemed to define an additional aspect of the invention, however, the individual reconsideration of the patentability of each on its own merits is respectfully requested.

**CONCLUSION**

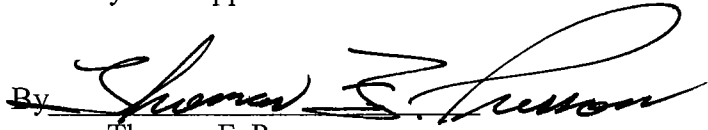
In the event the Examiner disagrees with any of statements appearing above with respect to the disclosure in the cited reference, it is respectfully requested that the Examiner specifically indicate those portion or portions of the reference, providing the basis for a contrary view.

Please charge any additional fees that may be needed, and credit any overpayment, to our Deposit Account No. 50-0320.

In view of the foregoing remarks, it is believed that all of the claims in this application are patentable and Applicants respectfully request early passage to issue of the present application.

Respectfully submitted,

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